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Katrin Reisinger

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EXAMINER

NELSON, FREDA ANN

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/797,838
Filing Date: March 10, 2004
Appellant(s): REISINGER, KATRIN

Steven H. Noll
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 28, 2008 appealing from the Office action mailed April 29, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 5,040,132	SCHURICHT ET	08-1991
US 5,602,382	ULVR ET AL.	02-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuricht et al., (U.S. Patent No. 5,040,132) in view of Ulvr et al.(U.S. Patent No. 5,602,382).

7. **As per claim 1**, Schuricht teaches a mail-processing device comprising:
a microprocessor (Schuricht: Figure 1, "1"; col. 2, lines 28-39);

a keyboard with operating elements connected to said microprocessor for entering shipping information into said microprocessor (Schuricht: Figure 1, "2"; col. 1, lines 51-53);

a working memory accessible by said microprocessor containing mail-item-related data values (Schuricht: Figure 1, "6" and Figure 2);

a programmable memory and a program memory accessible by said microprocessor (Schuricht: Figure 1, "6"; col. 2, lines 40-44);

in at least one of said program memory and said programmable memory, a first memory area containing a program that evaluates said mail-item-related data values

stored in the working memory to cause said mail-item-related data values to be permanently or temporarily stored (Schuricht: col. 2, lines 37-44), a second memory area containing a first table for indices respectively assigned to different postal authority-defined product codes, said product codes being ascendingly or consecutively stored in said table in a column and said table having a second column, in parallel with said first column, containing indices for different product descriptions (Schuricht: Figures 2B and 2C; col. 1, lines 24-27, "parcel post"; col. 3, lines 19-59 - The Examiner notes, the different shipping modes and rate codes to represent the different products. The Examiner further notes, it is in the basic knowledge of the skilled artisan that a rate table contains multiple columns and indices. The applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to in re Jacoby, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In In re Bode, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein.), and a third memory range for storage of a further table for said product descriptions respectively assigned to said indices in said second column (Schuricht: Figure 2A; The Examiner notes, a further table for the said product descriptions can be the receiver address and location code.); and

said microprocessor being programmed by said program for evaluating the mail-item-related data values stored in the working memory by accessing said table containing said first and second columns to automatically determine a product code and

a product description for said service product (Schuricht: Figures 2 and 12; col. 1, lines 35-38; col. 4, lines 52-68 - col.5, lines 1-7), and to supply as an output a text for said product description for generating a printout thereof (Schuricht: col. 3, lines 50-55; col. 4, lines 38-51, "Each information block 16 contains the control commands and text information data required for causing the printer to print out the form or forms required for a certain shipping mode.").

8. Schuricht does not teach country-specific codes.

9. However, Ulvr et al. teaches country-specific codes (Ulvr et al.: Fig. 5; col. 9, lines 24-54, "country code")

10. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schuricht to have included country-specific codes as taught by Ulvr et al. for the advantage of complying with the postal code requirements of other countries when necessary during mail processing (Ulvr et al.: col. 9, lines 53-54).

11. **As per claim 2**, Schuricht in view of Ulvr et al. teaches the mail-processing device as claimed in claim 1 as described above. Schuricht further teaches the said microprocessor is programmed to determine the index for the product code and to locate the index in said further table for said product description (Schuricht: col. 3, lines 60-68; col. 4, lines 1-15).

12. **As per claim 3**, Schuricht in view of Ulvr et al. teaches the mail-processing

device as claimed in claim 1 as described above. Schuricht further teaches a fourth memory area for storage of an additional further table containing text strings assigned to the respective indices, and wherein said microprocessor is programmed by said program to determine a text string from said additional further table dependent on shipping parameters for said service product and to supply said text strings in said output (Schuricht: Figure 2C; column 4, lines 30-37 - The Examiner interprets the supplement portion within memory 15 to be a fourth memory area, which is separate from the rate table. The Examiner notes, the information located in memory 15 (Figure 2C) is supplied to a printer (Schuricht: col. 4, lines 46-51)).

13. **As per claim 4**, Schuricht in view of Ulvr et al. teaches the mail-processing device as claimed in claim 1 as described above. Schuricht further teaches the program memory is a permanent memory and wherein said programmable memory is a semi-permanent memory (Schuricht: col. 9, lines 30-43).

(10) Response to Argument

1. Independent Claim 1:

Appellant's first argument appearing on Pages 3-4 of the Appeal Brief is that *"the term 'product code' is a term with a specific, well-documented meaning in the context of mail processing" as is explained on page three of the present specification and "the patent that issued as the Schuricht et al. reference was originally filed on may 15, 1989,*

which was long before any type of governmentally-defined product codes were in existence".

In response to appellant's argument, the examiner asserts that Appellant's specification does not provide a special definition for the term "product code". Appellant merely provides examples of "product codes" that are used in various countries. Therefore, the term "product code" is not limited to the recent conception and usage of "product codes" in the context of the examples as described by Appellant. As such, any argument regarding the date of the cited references with respect to Applicant's invention is not a particularly relevant issue at hand. The Examiner notes, *Renishaw PLC v. Marposs Societa 'per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) ("The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim."). In addition, other court decisions have indicated that if an inventor is relying on a special meaning for terms appearing in the claims, then the special meaning must be clearly written in the specification. See *In re Thrift*, 63 USPQ2d 2002 (Fed. Cir. 2002) ("Although an applicant may be his own lexicographer...nothing ~ the specification defines the phrase "speech user agent" differently from its ordinary meaning."). Thus, while Appellant may have a specific and particular "product code" in mind, the specification fails to define the term "product code" to be this particular code with exactness and precision. Moreover, USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. See *In re Morris'*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023,

1027-28 (Fed. Cir. 1997). Also see *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow...") and *In re Pearson*, 181 USPQ 641 (CCPA 1974) (Claims in a pending application should be given their broadest possible interpretation). Using a broad and reasonable interpretation, one of ordinary skill in the art would recognize that the term "product code" can be any code that relates to a particular type of service in the mail industry. Schuricht teaches a rate code (product code) that pertains to the type/class of service desired (Schuricht: Figs. 2B and 2C; col. 3, lines 19-59). These rate codes and corresponding rate tables can be for a carrier postal service (Schuricht: col. 4, lines 1-3).

Appellant's further argues on Page 5 of the Appeal Brief that the Schuricht et al. reference discloses storage of certain types of codes associated with certain types of services which are not *"and cannot be governmentally-defined product codes"*.

In response to appellant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., governmentally-defined product codes) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant's argument appearing on Page 5 of the Appeal Brief is that "*Ulvrr et al. reference, like the Schuricht et al. reference, has a filing date and a publication date that are significantly earlier than the recent conception and usage of product codes*" and "*the Ulvr et al. reference does not and cannot provide any guidance to a person of ordinary skill in the field of designing postage meters with regard to the incorporation of an automatic designation of a product code in such a postage meter*".

In response to appellant's argument, the examiner asserts that Schuricht et al. disclose a system for *automatically preparing documents* for shipping articles to any desired number of different receivers by any selected shipping mode (col. 1, lines 35-38); FIG. 12 (a) and (b) a schematic flow chart of the control flow of the system in an automatic shipping operation with automatic access to a transportation rate table (col. 2, lines 21-24); and FIGS. 12 (a) and (b) illustrate the operation of the system when it is issued to prepare shipping documents. The process begins with selection of the desired recipient. This can be accomplished by entry via the keyboard of the recipient's name (steps 34 and 35) or address (steps 32 and 33) or an identifying code (steps 34 and 35) or entry of only a portion of one of those items (col. 4, line 52 through col. 5, line 7). The Examiner also asserts that Appellant's specification does not provide a special definition for the term "product code". Appellant merely provides examples of "product codes" that are used in various countries. Therefore, the term "product code" is not limited to the recent conception and usage of "product codes" in the context of the examples as described by Appellant. As such, any argument regarding the date of the cited references with respect to Applicant's invention is not a

particularly relevant issue at hand. The Examiner notes, *Renishaw PLC v. Marposs Societa 'per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) ("The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim."). In addition, other court decisions have indicated that if an inventor is relying on a special meaning for terms appearing in the claims, then the special meaning must be clearly written in the specification. See *In re Thrift*, 63 USPQ2d 2002 (Fed. Cir. 2002) ("Although an applicant may be his own lexicographer...nothing ~ the specification defines the phrase "speech user agent" differently from its ordinary meaning."). Thus, while Appellant may have a specific and particular "product code" in mind, the specification fails to define the term "product code" to be this particular code with exactness and precision. Moreover, USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. See *In re Morris*', 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Also see *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow...") and *In re Pearson*, 181 USPQ 641 (CCPA 1974) (Claims in a pending application should be given their broadest possible interpretation). Using a broad and reasonable interpretation, one of ordinary skill in the art would recognize that the term "product code" can be any code that relates to a particular type of service in the mail industry. *Schuricht et al.* teaches a rate code (product code) that pertains to the type/class of service desired (*Schuricht*: Figs. 2B and 2C; col. 3, lines 19-59). These

rate codes and corresponding rate tables can be for a carrier postal service (Schuricht: col. 4, lines 1-3)

Appellant's further argues on Page 6 of the Appeal Brief that the "Examiner has unjustifiably, and without any explanation, equated the usage of country codes with the much more recent usage of product codes".

In response to Appellant's argument the Examiner asserts that Ulvr et al. disclose the use of the data content identifier allows the code to be used for different customer and Post Office applied applications in which the code structure, length and content varies. The data field may contain a postal code with or without an address locator, a machine ID, customer information and service information. The code may include a country code field for mail pieces that are being mailed to a different country. The code may also include a field indicating whether the codeword is complete or whether it has to be concatenated with a preceding or subsequent codeword (abstract). The Examiner maintains that Ulvr teaches using country-specific codes for mail and it is the combination of Schuricht et al. in view of Ulvr that teaches all the limitations of claim 1 as written.

Appellant's argument on Page 7 of the Appeal Brief is that "it is the epitome of hindsight and unjustified use of the Appellant's disclosure to reject the claims of the present application using references that, because of their dates, do not and cannot

provide any insight into the use of product codes in any form, much less in an automated manner”.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

2. Dependent Claims 2-4:

See reasoning applied to claim 1.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Freda A. Nelson/
Examiner, Art Unit 3628

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